



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,234	11/07/2001	Douglas F. Libra	00-348	6984
74576	7590	11/09/2009	EXAMINER	
HUGH P. GORTLER			STERRETT, JONATHAN G	
23 Arrivo Drive				
Mission Viejo, CA 92692			ART UNIT	PAPER NUMBER
			3623	
			MAIL DATE	DELIVERY MODE
			11/09/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/008,234	Applicant(s) LIBRA ET AL.
	Examiner JONATHAN G. STERRETT	Art Unit 3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 03 August 2009.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 and 39-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,39-46 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/0256/06)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application
 6) Other: _____

DETAILED ACTION

Summary

1. This Final Rejection is responsive to August 3, 2009. Currently **Claims 1 and 39-46** are pending.

Response to Argument

2. The applicant argues that the claims are statutory re 35 USC 101.

The examiner respectfully disagrees.

The claimed steps in 1 and 39 still do not clearly recite a tie to a particular machine or apparatus. The steps which constitute the novel aspect(s) of a method claim should have a recitation that ties that step(s) to a particular machine or apparatus. Storing or displaying data are only insignificant pre or post solution activity. Also reciting that a method is "computer implemented" in the preamble does not make the steps have a requisite tie. For example, a person can prepare their taxes "using a computer", e.g. to enter data into a spreadsheet or using a calculator onscreen, and while that effort is "computer implemented" the essential steps are performed by the person, not the computer.

The applicant argues that the Smart reference fails to teach inputting information about an issue resolution.

The examiner respectfully disagrees.

The limitation regards intended use. Because the applicant's invention inputs information regarding an issue that is different than what Smart teaches is irrelevant,

since both are issues that need resolution. The applicant's claims are broader than what is disclosed in the specification, regarding issue resolution regarding test scripts and software testing on the part of suppliers.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 43 and 44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 43 claims a system to perform the method steps of Claim 39, however, no system elements are claimed. It is not clear which method steps in claim 39 would be performed by which system element, since no system elements are claimed. Additionally, one could infringe the method claim of claim 39 by performing the method steps (which have no particular machine tied to them) and yet not infringe the system claim of claim 43. If the applicant wishes to claim a system that performs the method steps of claim 39, the examiner requests the applicant file a separate independent claim with positively recited elements.

Similarly, **claim 44** appears to recite computer readable memory as an article of manufacture where the memory is of the computer system of claim 39. Again, this is improper since the applicant appears to want to claim essentially "A computer readable medium which when executed by a computer perform the method steps of claim 39".

(This is what the examiner interprets this claim to mean, for examination purposes).

However, what the applicant has claimed is only the computer memory of the computer system of Claim 39. This is barely limiting over claim 39 since all that is being claimed is "the computer memory" – i.e. the memory in a computer system only stores data. As for Claim 43, the examiner requests the applicant file a separate independent claim that recites "A computer readable medium which when executed by a computer perform the following steps". (The examiner notes that such an independent claim does not require a positive recitation in the steps for a tie to a particular machine or apparatus, that applies to method or process claims).

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 39-44 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1 and 39 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to

a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be performed without the use of a particular apparatus. Thus, **Claims 1 and 39** are non-statutory. **Claims 40-44** depend on **Claim 39** and are similarly not statutory.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1 and 39-46** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Pyron** (Using Microsoft Project 98: Special Edition) in view of **Smart** U.S. 5241621 (hereinafter **Smart**) and further in view of **Heckerman** U.S. 5715374 (hereinafter **Heckerman**).

As per claim 1, Pyron teaches a method comprising: **collaboratively performing a number of tasks by a plurality of parties, wherein each task requires a series of collaborative actions** (See pages 565-6, 586, 926, wherein workgroups of members perform a number of tasks with actions, wherein the actions are cooperative. See pages 50-1, 126, 171, 173, 175, 177, wherein actions in phases of tasks influence the actions and tasks of others);

recording the series of collaborative actions into a script database (See pages 65, 171, 175-9, 125-7, 599-601, wherein the tasks and subtasks are stored in an order/script in the database);

displaying a status of the series of collaborative actions taken in each of the tasks (See 473,484-6, 526-8, wherein status is displayed), wherein the status of each task may be simultaneously viewed by one or more of the plurality of parties (See 565-8, 575, 586-7, wherein the status can be viewed by workgroup members), and wherein displaying the status includes:

indicating two or more tasks including at least one of indicating whether a part has not started, is in work, or has been completed (See pages 484-6 and 526-8, wherein task status is displayed);

indicating a last action completed within each of the tasks that are in work (See at least pages 50-2, 484-6, 491-2, wherein the status of all tasks and subtasks (actions) is tracked and displayed, with the last action completed and other completions displayed);

displaying a total number of actions in each of the tasks (See pages 50-1,126, 171,173, 175, 177, wherein tasks and subtasks (actions) are displayed);

displaying a percentage of the number of actions completed for each of the tasks (See pages 50-2, 484-6, 491-2, 526-8, 924, wherein percentage completion is displayed); and

for each task, displaying a bar graph having a shaded portion corresponding to a percentage of the assigned actions completed for each of the tasks (See pages 484-6, 491-2, 526-8,924).

However, Pyron does not expressly disclose recording at least one issue and at least one issue resolution associated with at least one of the tasks into an issue database, wherein the at least one issue and the at least one issue resolution are inputted by a user.

Smart discloses recording **at least one issue and at least one issue resolution associated with at least one of the tasks into an issue database and at least one**

comment on the at least one resolution, wherein the at least one issue and the at least one issue resolution are inputted by a user (see abstract – issue information is stored in a database and column 5 line 10-17; column 10 line 38-43).

Both Pyron and Smart disclose management systems which coordinate between a plurality of individuals when performing management planning. Smart specifically discloses managing issues that arise during general management including planning and resolving these issues and conflicts. It would have been obvious to one of ordinary skill in the art at the time of the invention to include the recording of issues and resolutions into an issue database in order to more efficiently manage a collaborative project by allowing easier interaction between individuals regarding conflicts that arise.

Pyron and Smart do not teach:

At least one comment on the at least one issue resolution

Heckerman teaches:

At least one comment on the at least one issue resolution

Column 1 line 40-45, Heckerman teaches that a comment on a problem solution is made as to whether the “issue resolutions”, i.e. the solution, is effective or not (see also column 8 line 45-50). Heckerman teaches that this provides a way to validate “solutions” that proposed to problems (see abstract and column 1 line 40-45).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Pyron and smart to include where comments are made regarding at least one issue resolution, because it would have provided a predictable result in offering users to validate solutions that were applied through commenting on the solutions proposed and applied to problems.

Claims 39, 45 and 46 recite similar limitations to those addressed by the rejection of **Claim 1** above, and is therefore rejected under the same rationale.

Regarding **Claim 40**, the above references all teach using a computer for their various teachings (i.e. including an interface for the user that is computerized), however, they do not teach where the computers interact over a network or the internet. However, Official Notice is taken that using a network to provide for computers to interact is old and well known in the art and would have been obvious to combine with the above teachings because it would have provided the obvious advantage of operating the method with a global reach since the method would have been performed using the internet.

Claims 41 and 42 recite intended use limitations and do not further limit the claims.

Regarding **Claim 43**, all the references teach using a computer (i.e. a computer system) to perform the method.

Regarding **Claim 44**, all the references teach the use of software (ie. an article of manufacture on computer readable medium

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Information support for new product development teams

R Sharda, GL Frankwick, A Deosthali, R ..., 1999 - catt.bus.okstate.edu.

Positioning for Success: The Innovation of Virtual Teams

GA Hajzak, 1998 - dtic.mil

US 5872924 by Nakayama discloses a collaborative work sharing system.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan G Sterrett whose telephone number is (571)272-6881. The examiner can normally be reached on M-F, 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on 571-272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3623

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JGS

November 7, 2009

/Jonathan G. Sterrett/

Primary Examiner, Art Unit 3623